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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CORSARO, NICK

ART UNIT PAPER NUMBER

2684

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/390,946	LAKE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nick Corsaro	2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, 12 and 14-19 is/are rejected.
- 7) ☒ Claim(s) 11 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>g</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## RESPONSE TO AMENDMENT

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Issues regarding newly added claims are addressed in the following claim rejections.

### *Specification*

2. The abstract of the disclosure is objected to because the abstract is too long. Correction is required. See MPEP § 608.01(b).
3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. (6,442,598) in view of Palmer et al. (5,905,865).

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Consider claim 1, Consider claim 1, Wright discloses a method of distributing digital information (see abstract lines 1-2, col. 5 lines 22-35, and col. 9 lines 30-45). Wright discloses receiving broadcast signal in a receiver unit, said broadcast signal carrying at least one encoded hypermedia document (see col. 5 lines 22-35, col. 5 lines 62-67, col. 5 lines 22-67, col. 6 lines 4-16, and col. 11 lines 30-45). Wright discloses processing said broadcast signal to extract said encoded hypermedia document; and processing said encoded hypermedia document with a hypermedia processing program (see col. 7 lines 8-15, col. 5 lines 20-35, col. 11 lines 32-67, col. 12 lines 1-67 and col. 13 lines 1-26, and col. 16 lines 20-30, where Wright discusses the client terminals receive broadcast packets with web pages, in hypertext form and unpack it for use on a internet browser).

Wright does not specifically disclose the processing resulting in a connection without user interaction, to an Internet address referenced in the encoded hypermedia document. Palmer teaches the processing resulting in a connection without user interaction, to an Internet address referenced in the encoded hypermedia document (see col. 4 lines 64-67, col. 5 lines 1-43, and col. 8 lines 5-33).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Wright, and have the processing resulting in a connection without user interaction, to an internet address referenced in the encoded hypermedia document, as taught by Palmer, thus alleviating the user from having to enter initiate the connection to the internet address, as discussed by Palmer (col. col. 3 lines 27-45).

Consider claim 16, Wright discloses an interactive broadcast system (see abstract lines 1-15, and col. 4 lines 5-11). Wright discloses a transmitter to broadcast a broadcast signal carrying

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inherent audio and at least one broadcast markup language document (see col. 10 lines 28-56, col. 9 lines 30-45, and col. 5 lines 22-67, where Wright discusses inserting the markup language files in the blanking interval of a TV broadcast, therefore, having audio). Wright discloses authoring software to form and sequence interactive broadcast markup language commands to create the at least one broadcast markup language document using the interactive broadcast markup language commands, and to insert the at least one broadcast markup language document into the broadcast signal (see col. 5 lines 40-67 and col. 6 lines 1-16, and col. col. 7 lines 7-55, and col. 10 lines 25-52, where Wright discusses a server and a administrator constructing the Web pages in the broadcast signal). Wright discloses the broadcast signal is subsequently processed by the receiver to connect with user interaction to an Internet address referenced in the markup language document (see col. 11 lines 32-67).

Wright discloses the receiving client device can connect to Web sites by user activation of a URL contained in the received web pages (see col. 11 lines 50-67, col. 12 lines 1-7, and col. 13 lines 1-7).

Wright does not specifically disclose the broadcast signal is subsequently processed by the receiver to connect, without user interaction to an Internet address referenced in the at least one broadcast markup language document. Palmer teaches the broadcast signal is subsequently processed by the receiver to connect, without user interaction to an Internet address referenced in the at least one broadcast markup language document (see col. 4 lines 64-67, col. 5 lines 1-43, and col. 8 lines 5-33).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Wright, and have the broadcast signal is subsequently

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processed by the receiver to connect, without user interaction to an internet address referenced in the at least one broadcast markup language document, as taught by Palmer, thus alleviating the user from having to enter initiate the connection to the internet address, as discussed by Palmer (col. col. 3 lines 27-45).

6. Claim 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. (6,442,598) in view of Palmer, as applied to claim 1 above, and further in view of Takahisa et al. (5,564,073).

Consider claim 3, Wright and Palmer discloses a broadcast system for broadcasting hypertext material. Palmer further discloses making special offers and coupons available to the user (see col. 6 lines 65-67 and col. 7 lines 1-6). Wright and Palmer do not specifically disclose a listener credit. Takahisa teaches listener credit (see col. 12 lines 10-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Wright and Palmer, and have a listener credit, as taught by Takahisa, thus allowing data associated with a broadcast to be transmitted, as discussed by Takashi (col. 1 lines 50-57).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. (6,442,598) in view of Palmer, as applied to claim 1, above, and further in view of Logan et al. (6,088,455).

Consider claim 5, Wright discloses broadcasting hypermedia (see col. 5 lines 20-67). Wright and Palmer do not specifically disclose recording for replay. Logan teaches recording for replay (see col. 7 lines 12-55, col. 8 lines 12-35, and col. 2 lines 22-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Wright and Palmer, and record for replay, as taught by Logan, thus allowing editing

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of radio broadcast signals for providing personalized programs, as discussed by Logan (col. 2 lines 9-20).

8. Claims 6, 7, 10, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. (6,442,598) in view of Palmer, as applied to claim 1 above, and further in view of Payne et al. (6,021,433).

Consider claims 6, 7, 10, 15, and 17, Wright discloses the method, as modified by Palmer above. Wright and Palmer disclose the system wherein a database of the hypertext is stored with alerts and automatic connections are available (see Wright, col. 11 lines 31-67, and Palmer col. 4 lines 64-67, col. 5 lines 1-43, and col. 8 lines 5-33). Wright and Palmer do not specifically disclose the storing of particular URL for direct connections based on user particular ID based on notifiers. Payne teaches the storing of particular URL for direct connections based on user particular ID based on notifiers (see col. 6 lines 5-60, col. 13 lines 50-67, and col. 8 lines 15-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Wright and Palmer, and have storing of particular URL for direct connections based on notifiers, as taught by Payne, thus allowing the combination of broadcast and wire-line services to enhance broadcast services by allowing users immediate notifications of services, as discussed by Payne, (col. 2 lines 14-40).

9. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al. (5,905,865) in view of Graham et al. (5,572,201).

Consider claim 2, Palmer discloses an interactive broadcast reception system including a general-purpose computer (see abstract lines 1-3, and col. 1 lines 60-64). Palmer discloses a processor, display, and storage and Internet connection (see col. 3 lines 50-67 and col. 4 lines 10-

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27). Palmer discloses a broadcast receiver (30, figure 1) to communicate with the general purpose computer and to decode sub-carrier data formatted as a broadcast markup language document (see col. 4 lines 1-10, col. 4 lines 58-67, col. 5 lines 1-44, col. 6 lines 7-29, col. 7 lines 45-54, and col. 8 lines 5-33, where Palmer discusses that the computer has a receiver for receiving a web page or URL from a broadcast transmitter, where the tower could be a paging broadcast transmitter or a traditional AM, FM, HAM, broadcast transmitter and the signal could be a part of the broadcast signal such as the blanking interval or much like closed captioning, i.e., a sub-carrier). Palmer discloses application software that runs; on the processor of the computer and communicates with the broadcast receiver to control the operation of the broadcast receiver and respond to said broadcast markup language commands in said broadcast markup language document by connecting to an address in said sub-carrier data (see abstract lines 1-11, col. 4 lines 58-67, col. 5 lines 1-44, and col. 9 lines 1-15).

Palmer discloses using sub-carriers to send the information, where it is common in the industry to use digital sub-carriers (col. 8 lines 5-32), however, Palmer does not specifically disclose a digital sub-carrier. Graham teaches a digital sub-carrier (see col. 6 lines 45-60, and col. 17 lines 15-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Palmer, and have the digital sub-carrier, as taught by Graham, thus allowing auxiliary information to sent with the normal radio broadcast, as discussed by Graham (col. 1 lines 10-43).

Consider claim 9, Palmer does not specifically disclose the receiver is separable from the general-purpose computer. Official notice is taken that having a receiver separable from a



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general-purpose computer is well known and expected in the art to allow modifications and additions to be made to personal computers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Palmer, and have the receiver separable from a general-purpose computer thus allowing any general-purpose computer to be retrofitted with a wireless receiver.

10. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer in view of Graham as applied to claim 2 above, and further in view of Weinstein et al. (6,604,242).

Consider claims 8 and 14, Palmer discloses the method and system, as modified by Graham, above. Palmer and Graham do not specifically disclose the language is formatted in the XML standard. Weinstein teaches the language is formatted in the XML standard (see col. 1 lines 52-65 and col. 6 45-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Palmer and Graham, and use XML, as taught by Weinstein, thus allowing the combination of interactive broadcasts and Web servers, as discussed by Weinstein (col. 1 lines 22-67).

11. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al. (5,905,865) in view of Takahisa et al. (5,564,073).

Consider claim 18, Palmer discloses a method of distributing digital information comprising receiving a broadcast signal in a receiver unit, the broadcast signal carrying at least one encoded hypermedia document; processing the broadcast signal to extract the encoded hypermedia document; and processing the encoded hypermedia document with a hypermedia processing program the processing resulting in special offers, discounts and incentives to the

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listener (see col. 6 lines 65-67, col. 7 lines 1-5, lines 1-3, col. 1 lines 60-64, see col. 3 lines 50-67, col. 4 lines 10-27, col. 4 lines 1-10, col. 4 lines 58-67, col. 5 lines 1-44, col. 6 lines 7-29, col. 7 lines 45-54, col. 8 lines 5-33, lines 1-11, col. 4 lines 58-67, col. 5 lines 1-44, and col. 9 lines 1-15).

Palmer does not specifically disclose the redemption of listener credits. Takahisa teaches the redemption of listener credits (see col. 12 lines 10-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Palmer, and have redemption of listener credits, as taught by Takahisa, thus allowing data associated with the broadcast to be transmitted, as discussed by Takahisa, (col. 1 lines 50-67).

Consider claim 19, Palmer discloses special offers to the user, inherently saved by the computer, in buffer or memory (see col. 6 lines 65-67 and col. 7 lines 1-7, where palmer discloses sending the special offers, where the user has a computer, therefore, in order to be viewed at all they must be stored someplace temporarily or permanently).

Palmer does not specifically disclose the redemption of listener credits. Takahisa teaches the redemption of listener credits (see col. 12 lines 10-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Palmer, and have redemption of listener credits, as taught by Takahisa, thus allowing data associated with the broadcast to be transmitted, as discussed by Takahisa, (col. 1 lines 50-67).

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*Allowable Subject Matter*

12. Claims 11 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nick Corsaro whose telephone number is 703-306-5616. The examiner can normally be reached on 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay A Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information

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regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nick Corsaro

**NICK CORSARO  
PATENT EXAMINER**

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